

Remarks

Claims 1 and 92 are pending. Claims 1 and 92 stand rejected. Claims 1 and 92 have been amended to conform with the elected group. Specifically, R has been limited to H, alkyl, aralkyl, cycloalkyl, alkenyl, aryl, acyl, or sulfonyl; R₂ has been limited to RO-alkyl, (R)₂N-alkyl, RS-alkyl, (R)₂N-cycloalkyl, or RS-cycloalkyl; and R₃ and R₄ have been limited to H, alkyl, -OR, or F. Moreover, no new matter has been added.

Importantly, the claim amendments should not be construed to be an acquiescence to any of the claim rejections. Rather, the amendments to the claims are being made solely to expedite prosecution of the above-identified application. The Applicant expressly reserves the right to further prosecute the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application. 35 USC § 120.

Response to Claim Rejections Based on 35 USC § 112¶2

Claim 1 and 92 stand rejected under 35 USC § 112¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Examiner quotes the definition of “aryl” presented in the instant specification in support of the contention that one of ordinary skill in the art would interpret that term to include “non-hetero aromatic ring[s]”. The Examiner also states that “the claims do not clearly indicate this”. Therefore, solely in an effort to expedite prosecution, the Applicant has amended the definition of R₁ in claim 1 to recite “optionally substituted carbocyclic aryl.” Further, the definition of R₁ in claim 92 was already limited to “optionally substituted phenyl”; this limitation explicitly excludes heteroaromatic rings.

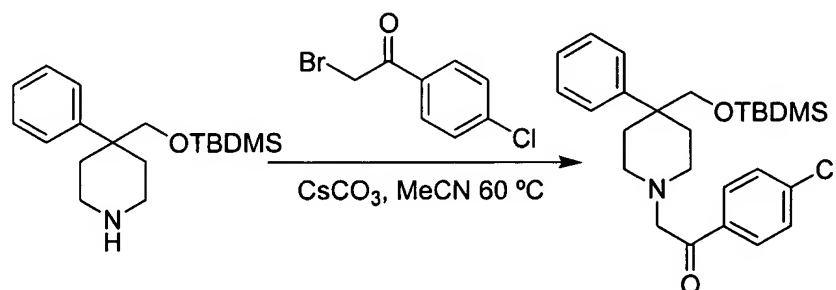
Accordingly, the Applicant respectfully requests the withdrawal of the claim rejections based on 35 USC § 112¶2.

Response to Claim Rejections Based on 35 USC § 112¶1

Claims 1 and 92 stand rejected under 35 USC 112¶1 for allegedly lacking enablement. Specifically, the Examiner asserts that the specification is only enabling for substitution on the

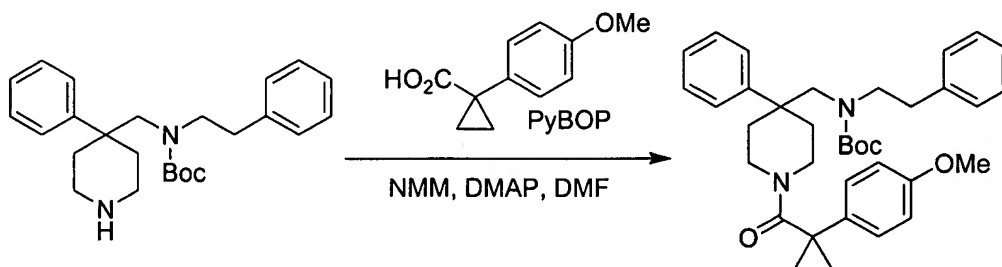
“phenyl” to be a fluorine, chlorine or methoxy. Importantly, by “phenyl” the Applicant understands the Examiner to refer to the R⁵ substituent. The Applicant respectfully disagrees with this contention; the Examiner’s attention is respectfully directed to the Exemplification.

Example 11 in the instant application provides instruction on how to conduct the following reaction:



As depicted above, an S_N2 displacement involving the unsubstituted piperidine nitrogen is all that is needed to introduce a chlorine-substituted phenyl into the compound at the position corresponding to R₅. Further, the Applicant respectfully contends that the level of ordinary skill in the art of organic synthesis is a Ph.D. Moreover, the Applicant contends that a Ph.D.-trained synthetic chemist would have no difficulties synthesizing equivalent compounds containing a phenyl ring with differing substitutions.

Further, Example 18 provides the following experimental procedure:



In this procedure an acylation is used to introduce a methoxy-substituted phenyl. The number of acylating reagents available commercially; for which synthetic routes exist in the public domain; and/or which can be synthesized by one of ordinary skill in the art of organic chemistry without undue experimentation; would enable one of ordinary skill in the art to prepare a large number of the claimed compounds comprising R₅ phenyl moieties with varied substitutions. Given that two methods are presented for forming compounds with varied substituents on the phenyl rings, the Applicant respectfully suggests that there is sufficient

teaching to enable one of skill in the art to synthesize the range of compounds claimed without the need to resort to undue experimentation.

The Applicant now addresses the Examiner's assertion that the act of synthesizing the inventive compounds would constitute "undue" experimentation. The second paragraph of MPEP 2164.06 clearly states that "[t]ime and difficulty of experiments are not determinative [of undue experimentation] if they are merely routine. Quantity of examples is only one factor that must be considered before reaching the final conclusion that undue experimentation would be required. In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404." The Applicant asserts that the work needed to synthesize the claimed compounds, given the teachings of the application, might in certain instances be time-consuming, but would always be routine, especially since the nature of the substituent on the phenyl ring would not drastically effect either the displacement or acylation reaction protocols provided in the application (and discussed above). Accordingly, the Applicants respectfully contend that any required experimentation would not be "undue."

Accordingly, the Applicant respectfully requests the withdrawal of the rejections based on 35 USC § 112¶1.

Fees

The Applicants believe they have provided for the required fees in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any additional required fee to our Deposit Account **06-1448**; Reference **SPV-048.02**.

Conclusion

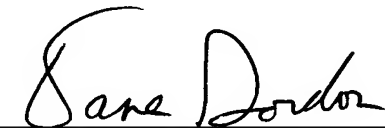
In view of the above amendments and remarks, the Applicant believes that the pending claims are in condition for allowance. If a telephone conversation with Applicant's Attorney would expedite prosecution of the application, the Examiner is urged to contact the undersigned.

Respectfully submitted,
Patent Group
Foley Hoag LLP

Foley Hoag LLP
155 Seaport Boulevard
Boston, MA 02210

Telephone: (617) 832-1000
Telecopier: (617) 832-7000

By: _____


Dana M. Gordon, PhD
Reg. No. 44,719
Attorney for Applicant

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